

Oral Hearing:
December 14, 1999

Paper No. 19
TEH

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 29, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re North American Publishing Company

Serial No. 75/050,595

Timothy D. Pecsenty of Blank Rome Comisky & McCauley LLP for
North American Publishing Company.

Steven Fine, Trademark Examining Attorney, Law Office 107 (Tom
Lamone, Managing Attorney).

Before Hohein, Walters and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

North American Publishing Company has filed an application
to register the mark IN-PLANT GRAPHICS for "magazines containing
materials of interest for persons in the printing and publishing
industries."¹

¹ Application Serial No. 75/050,595 filed January 30, 1996, alleging
dates of first use of January 1, 1996.

The Trademark Examining Attorney initially refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its goods. Instead of asserting that its mark is not descriptive, applicant amended the application to seek registration under Section 2(f) of the Act, in part, as to the term "IN-PLANT," based on applicant's ownership of a registration for the mark IN-PLANT REPRODUCTIONS for "magazines."² In addition, applicant offered to disclaim the term "GRAPHICS" apart from the mark as shown. The Examining Attorney, however, rejected applicant's Section 2(f) claim, arguing that IN-PLANT GRAPHICS is not the "same mark" as IN-PLANT REPRODUCTIONS for purposes of Trademark Rule 2.41(b), and continued the refusal to register under Section 2(e)(1). In response, applicant maintained its Section 2(f) claim on the basis of the prior registration and, for the first time, submitted arguments that its IN-PLANT GRAPHICS mark is not descriptive of its goods.

The Examining Attorney subsequently issued a final refusal under Section 2(e)(1) and, in support of his position, submitted several excerpts of stories from the LEXIS/NEXIS database to show

² Registration No. 1,584,618, issued February 27, 1990 under Section 2(f); combined affidavit under Sections 8 and 15 filed. There is nothing disclaimed in the registration.

descriptive use of IN-PLANT GRAPHICS. Applicant then filed a notice of appeal accompanied by a request for reconsideration wherein applicant relied on the declaration of its President, Ned Borowsky, as additional evidence of acquired distinctiveness. Applicant, however, did not continue to argue that its mark is not descriptive in the request for reconsideration.³ The request for reconsideration was denied.

Both applicant and the Examining Attorney filed briefs on appeal and an oral hearing was held.⁴

In support of its claim of acquired distinctiveness, applicant has relied on its ownership of a prior registration and the declaration of its President, Ned Borowsky. Applicant insists that, while not identical, its earlier mark, IN-PLANT REPRODUCTIONS, and its present mark, IN-PLANT GRAPHICS, are "the same" for purposes of Trademark Rule 2.41(b), with the present

³ We also note that applicant did not pursue such argument in its brief on appeal. Instead, the next mention of this argument is made in applicant's reply brief. As stated therein, "[t]hough Applicant strongly believes that the term IN-PLANT GRAPHICS is not at all descriptive, and ought to be registered based on its inherent distinctiveness, to aid in the speedy prosecution of its application, Applicant was willing to amend its application to seek registration under Section 2(f)...."

⁴ It was pointed out during the oral hearing that a copy of the declaration was not included with applicant's request for reconsideration. We note that this omission was not addressed by the Examining Attorney in his denial of the request for reconsideration. The Examining Attorney did not object to the late submission and a copy of the declaration was entered into the application following the conclusion of the hearing.

mark identifying merely an updated version of its prior IN-PLANT REPRODUCTIONS magazine. Applicant argues that the terms "REPRODUCTIONS" and "GRAPHICS" are "essentially and legally equivalent" and relies on Internet dictionary listings to support its contention, concluding that both words, as defined, "suggest a method of copying objects." In addition, applicant argues, based on its declaration, that the notice to applicant's subscribers announcing its magazine's change of name from IN-PLANT REPRODUCTIONS to IN-PLANT GRAPHICS is further evidence that the mark has acquired distinctiveness.

The Examining Attorney, on the other hand, essentially argues that as shown in applicant's specimens, the words "graphics" and "reproductions" do not have the same meaning and that applicant's notice to its readers about the name change is thus not relevant to the question of whether IN-PLANT GRAPHICS has acquired distinctiveness.

Generally, unless the question of inherent distinctiveness is clearly reserved, a claim of acquired distinctiveness under Section 2(f) is tantamount to a concession that the mark is not inherently distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) and *General Foods Corporation v. MGD Partners*, 224 USPQ 479, 485 (TTAB 1984). We find, from our review of the history of this case, and as clarified during the oral hearing,

that the question of whether the mark is merely descriptive is not an issue before the Board. Applicant has not clearly stated an intention to maintain alternative claims but, instead, has taken inconsistent positions on this matter throughout the prosecution of this case.⁵ Finally, in response to the Board's specific question on this issue at the oral hearing, applicant's counsel expressly stated that applicant was not arguing the Section 2(f) claim in the alternative. Under the circumstances, we treat any claim of inherent distinctiveness as waived and, since applicant's mark is accordingly regarded as merely descriptive within the meaning of Section 2(e)(1), the sole issue on appeal is the sufficiency of applicant's evidence under Section 2(f).⁶

We turn first to applicant's claim of acquired distinctiveness based on its ownership of a prior registration. We begin by noting that Section 7(b) of the Trademark Act provides that a registration on the Principal Register "shall be prima facie evidence of the validity of the registration,

⁵ We note that the Examining Attorney's argument in his brief is directed solely to the issue of the sufficiency of applicant's 2(f) evidence.

⁶ In any event, we find that the manner and context of use of IN-PLANT GRAPHICS in the NEXIS articles submitted by Examining Attorney as well as in applicant's own specimens clearly demonstrates that the relevant public would perceive IN-PLANT GRAPHICS as merely descriptive of applicant's goods.

registrant's ownership of the mark and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate." See also *In re Electro Products Laboratories, Inc.*, 156 USPQ 54 (TTAB 1967). Thus, Section 7(b) creates the basis for permitting reliance on an existing registration, under certain circumstances, to support a claim that distinctiveness has been transferred to a mark which is essentially the same as the registered mark. Further, Trademark Rule 2.41 provides that, in appropriate cases, "ownership of one or more prior registrations on the Principal Register...of the same mark may be accepted as prima facie evidence of distinctiveness."

The ultimate question in this appeal accordingly involves the determination of whether the earlier and later versions of applicant's marks are "the same" for purposes of Rule 2.41(b). Applicant is essentially seeking to "tack" the use of the registered mark to its use of the present mark for purposes of transferring distinctiveness to the new mark. See, for example, *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether applicant's present mark is "the same mark" as its previously registered mark, for purposes of that rule, is similar to the analysis used in "tacking" cases to determine whether a party may rely, for purposes of establishing priority, on its prior use of a mark which is not

identical to its present mark. See *In re Dial A Mattress Operating Corp.*, 52 USPQ2d 1910 (TTAB 1999) and TMEP section 1212.04. In this situation, the issue is whether the present mark and the previous mark are "legal equivalents." See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. *Compania Insular Tabacalera, S. A. v. Camacho Cigars, Inc.*, 167 USPQ 299 (TTAB 1970). Therefore, a minor difference in the marks, such as mere pluralization or an inconsequential modification or modernization of the later mark, would not be a proper basis for rejecting application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ 513 (TTAB 1984) *aff'd*, 769 F.2d 764 (Fed. Cir. 1985) and *In re Flex-O-Glass, Inc.*, *supra*. On the other hand, the fact that two marks may be confusingly similar does not necessarily mean that they are legal equivalents. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*, and *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

In this case, the two marks are not legal equivalents. Applicant's present mark IN-PLANT GRAPHICS, while perhaps similar to, is certainly not indistinguishable from, its registered mark

IN-PLANT REPRODUCTIONS. Moreover, contrary to applicant's contention, the words "GRAPHICS" and "REPRODUCTIONS" do not convey the same meaning or commercial impression. To use the definitions supplied by applicant (apparently obtained from the online version of *Webster's Dictionary*), the word "graphic" is defined as "the art or science of drawing a representation of an object on a two-dimensional surface...." and "reproduction" is defined as "something reproduced: copy." As can be seen from these definitions, the word "graphic" is the more expansive term which, while it may encompass the reproduction of an image, it is clearly not the equivalent of a reproduction. Thus, the definitions do not in any way demonstrate that these terms are interchangeable or that one word is a synonym for the other.

Moreover, applicant's own specimens reinforce the perception that the terms have separate and distinct meanings and commercial impressions. As stated on the cover of the magazine announcing the change of the magazine's name from IN-PLANT REPRODUCTIONS to IN-PLANT GRAPHICS (emphasis added):

Today, in-plants provide a wider variety of services than ever before:....In-plants also produce a larger variety of products than ever before....With all these changes, today's in-plant is no longer a **reproduction** center. It is a self-contained provider of a variety of products and services centered around the **graphic arts**.

Thus, applicant itself promotes the broader meaning of the term "graphics" to its subscribers in relation to the new version of

its magazine and in describing the new products and services provided by applicant under the new name. It would be inappropriate to permit applicant to transfer the distinctiveness of a mark with a narrow commercial impression onto one with a broader commercial impression. See, e.g., Van Dyne-Crotty, Inc. v. Wear-Guard Corp., supra,

Under the circumstances, applicant's ownership of its existing registration cannot be accepted as prima facie evidence of acquired distinctiveness.

We turn next to the additional evidence of acquired distinctiveness consisting of the declaration of applicant's President, Ned Borowsky. The substance of the declaration is that applicant "has notified all its subscribers of its magazine's change of name from IN-PLANT REPRODUCTIONS to IN-PLANT GRAPHICS" and that "[t]he subscriber list of IN-PLANT GRAPHICS is the same as that of IN-PLANT REPREDUCTIONS."

We find this evidence to be insufficient to establish that IN-PLANT GRAPHICS has acquired distinctiveness for applicant's magazines. Acquired distinctiveness is an association in the consumer's mind between the mark and the source of the goods or services. The act of notifying its subscribers of the change in the magazine's name simply does not demonstrate recognition by those subscribers of the new name as a mark. Absent specific evidence of, for example, the relevant market for the magazines,

circulation figures or the number of subscribers within that market, or the revenue generated from subscriptions, the mere fact that applicant may have notified existing subscribers of the change from one name to another is not particularly meaningful.⁷

In view of the foregoing, we find that the evidence of acquired distinctiveness submitted by applicant is insufficient to permit registration of IN-PLANT GRAPHICS for magazines under Section 2(f).

Decision: The refusal to register is affirmed.

G. D. Hohein

C. E. Walters

T. E. Holtzman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁷ The assertions by applicant's counsel in the appeal brief that applicant is "a well-known publisher in the industry" and that applicant's magazine "is strongly identified with its source" are unsupported, conclusory statements which can be given no weight.